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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,758	12/21/1998	GARY ANTHONY JUBB	M8540/185343	3326

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EXAMINER

GROUP, KARL E

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 04/08/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-17

Office Action SummaryApplication No.
09/202,758Applicant(s)
Jubb et alExaminer
Karl GroupArt Unit
1755**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 1, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-1-02 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-12 stand rejected for lacking an active process step. Applicants argue that "putting of that substance" is an active process step. This is not persuasive since the claims do not set forth a step of "adding" or "putting" a substance but set forth "including". The term "including" is considered to encompass the mere presence of a compound. It cannot be seen how the mere presence of a compound in a fiber may be an active process step. How does including 0% of a compound read on an active process step?

The claims also stand rejected since it is not clear if P_2O_5 and B_2O_3 are required. Applicants argue that both P_2O_5 and B_2O_3 are optional as long as one is present. Claim 8 clearly sets forth "including in the fiber composition a P_2O_5 former in an amount (emphasis added)".

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The terminology "in an amount" does NOT include 0%. Furthermore the claims do not claim one of P_2O_5 and B_2O_3 must be present. Claim 8 does set forth B_2O_3 as being optional but at least one of P_2O_5 and B_2O_3 terminology is not included in the claim.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Jensen et al (US 5,691,255; 5,614,449; WO 95/29135).

See examples 1-4 which fall within the ranges of the claims.

Although some of the examples in Jensen patents may not fall within the claimed formulas, some of the examples do. Note examples A-H in 5,614,449. A reference may be used for all it realistically teaches.

6. Claims 8,9,13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thelohan et al (US Re. 35,557 or 5,250,488).

See Ex. 3 in Table 1.

Applicants argue that Thelohan et al is not concerned with increasing the refractoriness of the fiber. This is not persuasive because the mere presence of the claimed compounds would inherently increase the refractoriness. Furthermore, heat resistance test were taken so refractoriness must have been a concern (see column 4, lines 62-66). Applicants did not argue the fiber claims 13 and 14.

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7. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Karppinen et al US 5,843,854 and WO 92/09536.

See compositions Ia and A in the Tables of column 3, 4 respectively. Furthermore composition Ib is within claims 8,9,10,12,14 where P_2O_5 is not required.

Applicants argue that Karppinen et al were not concerned with refractoriness. This is not persuasive since column 1, lines 14-15 recited for "heat insulation". Again the method steps only require the mere presence or inclusion of certain compounds.

8. Claims 8-10,12 and 14 are rejected under 35 U.S.C. 102(a,b or e) as being anticipated by Olds et al.

Also compositions in Table 4 are within the claims 8-10,12 and 14 which do not require P_2O_5 . Applicants argument that one of P_2O_5 and B_2O_3 must be present is not persuasive. Claims 10,12 and 14 set forth "optionally P_2O_5 and B_2O_3 " which does not require one or the other.

9. Claims 8-15 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Holstein et al (US 6,060,414; 6,037,284 and WO 93/22251).

Holstein et al '414 '284 and WO see Table 1, examples 2-6.

Applicants argue that Holstein is not concerned with refractoriness which is not persuasive in overcoming the rejection. The method claims require the mere inclusion of the components which Holstein teaches. No arguments to the fiber claims are presented.

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10. Claims 8-10, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jubb et al (WO 93/15028).

See compositions of Table 10 which fall within the claims that do not require P_2O_5 .

It is agreed that Jubb fails to teach P_2O_5 and B_2O_3 however the only claims that are rejected are the claims where P_2O_5 and B_2O_3 are "OPTIONAL" as recited in the claims.

11. All claims are drawn to the same invention claimed in the parent application prior to the filing of this request for continued examination under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Group whose telephone number is (703)308-3821. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703)308-3823. The fax phone number for this Group is (703)872-9310, for any non-final amendment or communication, and (703)872-9311 for any after-final amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.



**KARL GROUP
PRIMARY EXAMINER
ART UNIT 1755**

Keg
April 5, 2002